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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/427,775	10/26/1999	JERRY D. KIDD	TUEC.IP2005	3747

7590

11/10/2003

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EXAMINER

PADGETT, MARIANNE L

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/427,775

Applicant(s)

Kidd et al

Examiner

M.L. Padgett

Group Art Unit

1762

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11/22/02 + 1/3/03

☐ This action is FINAL

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-5, 7-17, 24-25, 27-50, 52-62, 64-68, 70-82, 85-88, 90-103, 105, 111-114, 117-129, 132 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 7-17, 24-25, 27-50, 52-62, 64-68, 70-82, 85-88, 90-103, 105, 111-114, 117-129, 132 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/02 has been entered.

2. The examiner notes that applicant sent in a response to the notice of non-compliance of December 20, 2002 on January 3, 2003, but that the case was never properly docketed to the examiner, so was not process.

3. The office no longer automatically sends figures to the Draft man for review. The examiner has no objection to the New Drawings submitted.

4. Claims 64-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While the majority of 112 issues discussed in section 1 of Paper No. 13, mailed 5/22/2002 have been corrected by amendment or clarified by the remarks, the problem of the SSPC standards remains, because calling something a "defined standard" does not provide any metes and bounds per se and it is the applicant's responsibility to provide enablement to their disclosure to the file. This problem may be corrected by supplying prior art copies of the standards to the case, so that what is being referenced will be part of the record. Presently, no such "standards" are available to the examiner for review or consideration.

5. Claims 64-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See section 3 above.

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. It is noted that while the patent to Grosman et al (5,078,847), discussed in section 3 of Paper No. 13 (mailed 5/22/2002), is directed to a coating procedure as claimed/discussed for substrates described as having "irregular shapes", Grosman et al does not illustrate, nor discuss the specific shape of threaded surfaces, and the coating process' consequent effect on galling on such a substrate surface.

8. Claims 1-5, 7, 8, 15-17, 24, 25, 27-28, 32-50, 52-57, 59-62, 64-81, 83-88, 90-95, 98-103, 105, 111-114 118-129 and 132 are, rejected under 35 U.S.C. 103(a) as being unpatentable over White (4,420,386 or 4,468,309), discussed in section 4, of paper No. 13.

The new feature in the claims concerning threaded surfaces and galling may be found in White (309) in the title, the abstract, Figures 1-3 and 6-7 (see the zigzag surface on substrate pipes 60 or 122, which typically represents threaded surfaces); column 2, lines 47-68; column 3, line 43-62; column 7, lines 38-48; and claims 1-30.

White (386) is not as explicit, however while the examples of Figures 1-3 and discussion thereof in column 2-4 are directed to circuit boards, Fig. 4 shows ref. No. 100, a pipe coupling having zigzag

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surfaces that one of ordinary skill in the art would interpret as being threads, and describes coating this surface and the desirability to use Ar at pressures below the typical 10-20 μ pressure for uniform films over very irregular surfaces. White (386) teach that their taught procedures (as discussed in paper No. 13) are intended for coating a variety of articles which are irregularly shaped, and the example of Fig. 4 as described on column 5, lines 3-39, directed to pipe couplings indicates coating of threaded surfaces, hence given the more detailed procedure and apparatus of the initial example on column 2-4 as discussed previously, White (386) also covers these new limitations.

Note that as the plasmas of the White references inherently have free electrons, which are inherently negative, this amended limitation is also covered. Also, see column 4, line 34-39 for discussion of the process effect on electrons in White (386) or column 5, lines 44-54 in White (309)

9. Claims 29-31 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (386 or 309) as applied to claims 1-5, 7-8, 15-17, 24-25, 27-28, 32-50, 52-57, 59-62, 64-81, 83-88, 90-95, 98-103, 105, 111-114, 118-129 and 132 above, and further in view of Grosman et al, as discussed in section 5 of Paper No. 13.

Note that as Grossman is generically directed to coating irregular surfaces, that is further motivation for combining with the processes of White treating threaded surfaces, a subset of irregular surfaces.

10. Claims 8-14 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (386 or 389) as applied to claims 1-5, 7-8, 15-17, 24-25, 27-28, 32-50, 52-57, 59-62, 64-81, 83-88, 90-95, 98-103, 105, 111-114, 118-129 and 132 above, and further in view of White (4,667,620) as applied in section 6 of the paper mailed May 22, 2002, No. 13.

11. Claims 96, 97 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (386 or 309) as applied to claims 1-5, 7-8, 15-17, 24-25, 27-28, 32-50, 52-57, 59-62, 64-81, 83-88,

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90-95, 98-103, 105, 111-114, 118-129 and 132 above, and further in view of Mattox, as applied in paper No. 13, section 8.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over White (309) as applied above, alone or in view of Sakamoto et al, as discussed in section No. 10 of paper No. 13, mailed May 22, 2002.

13. Applicant's arguments filed January 7, 2003 and April 22, 2002 and discussed above have been fully considered but they are not persuasive.

14. Any inquiry concerning this communication from the examiner should be directed to M. L. Padgett whose telephone number is (703) 308-2336 or after mid December (571) 272-1425. The examiner can generally be reached on Monday-Friday from about 8:30 a.m. to 4:30 p.m.; and fax phone numbers are (703) 872-9306 (all official).

M.L. Padgett/dh
November 5, 2003

November 7, 2003

**MARIANNE PADGETT
PRIMARY EXAMINER**